

18 AUG 2005



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

FISH & RICHARDSON P.C.
P O BOX 1022
MINNEAPOLIS MN 55400-1022

In re Application of SHUSTER et al.
Application No.: 10/500,444
PCT No.: PCT/US02/41834
Int. Filing: 31 December 2002
Priority Date: 31 December 2001
Attorney Docket No.: 14848-004US1
For: METHODS AND MATERIALS FOR
MODULATING TASK-3

DECISION ON
PETITION
UNDER 37 CFR 1.47(a)

This is a decision on applicant's petition under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 18 May 2005. Applicant also filed a request for a two month extension of time, which is granted.

BACKGROUND

On 29 June 2004, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 19 January 2005, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating that an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), and the surcharge for filing the oath or declaration after the thirty month period, was required.

On 18 May 2005, in response to the Notification of Missing Requirements, applicant filed a petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of inventor Ulf N.G. Arvidsson.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Items (1), (3) and (4) are satisfied.

With respect to item (2), Petitioner argues that Mr. Arvidsson is unavailable to sign the declaration, providing a statement of M. Angela Parsons, technologist specialist with Fish & Richardson. Ms. Parsons states that on 26 August 2004, she sent a declaration to Mr. Arvidsson's last known address via Federal Express (FedEx) (¶ 6). Ms. Parsons further states that after several weeks had passed and she had not received the signed Declaration, she looked at the electronic signature of the receiving party that is provided on the FedEx website (¶ 9). According to Ms. Parsons, "[t]he signature did not appear to be that of Ulf G. Arvidsson. Unfortunately, this page was not printed and it is not available at this time." Ms. Parsons' further explains that when the FedEx tracking number is now entered into the system, the name of the receiving party is a computer-entered name and is no longer the electronic signature. A copy of the E-mail shipping statement from FedEx dated August 31, 2004 regarding the shipment sent from M. Angela Parsons/Fish & Richardson to Ulf N.G. Arvidsson is attached as Exhibit D. The shipping statement indicates that the "package was delivered on 08/31/04 at 11:51 AM and signed for or released by U. Arvidsson." Petitioner has not provided and in fact, now cannot provide a copy of the electronic signature to show that it was not Mr. Arvidsson's signature to demonstrate that Mr. Arvidsson did not receive the shipment. Petitioner has not provided any evidence showing that the signature on the delivery does not match Mr. Arvidsson's signature. Thus, it cannot be concluded that Mr. Arvidsson is not available. Moreover, the attempts to locate Mr. Arvidsson by Internet searches were not successful, which is consistent with the delivery to his last known address.

The action taken by petitioner is not sufficient to prove that "a diligent effort" was made to contact the nonsigning inventor at his last known address by providing a copy of the application papers including specification, claims and drawings to Mr. Arvidsson's last known address. *See* MPEP 409.03(d). Under these circumstances, it cannot be concluded that Ulf N.G. Arvidsson is unavailable to sign the application. Petitioner has not demonstrated that: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 10/500,493 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature and (2) Ulf N.G. Arvidsson's unavailability after petitioner's diligent effort or Ulf N.G. Arvidsson's refusal to sign, either in writing or orally, these documents. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

It is noted that both Ms. Parsons' statement and her letters to each of the signing inventors indicate that she sent the inventors only declarations for five different U.S. applications. (Copies of her letters to each of the joint inventors were attached to her statement as Exhibit C.) In light of the above discussion, since the inventors were not provided with a copy of the complete application (that is, specification, claims and drawings), counsel is advised that each signing joint inventor should now be provided with a complete copy of the application papers (including specification, claims and drawings) for each application.

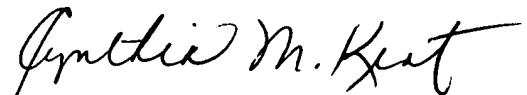
CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail

Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3286
Fax: (571)-272-0459
Fax: (571)-272-0459